

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claim 1 has been canceled. Claims 2 and 3 have been amended to provide their proper dependency. Claim 15 has been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and Action to that end is respectfully requested.

The Examiner rejected claims 1-14 under 35 U.S.C. § 102(b) as being anticipated by Gschwend, U.S. Patent No. 5,213,247 (Gschwend). It is respectfully submitted that claims 2-15, claim 1 having been canceled, are patentable over Gschwend.

Gschwend discloses a working tool (please see Figs. 1-3) having a housing (2), a guide cylinder (8) axially displaceable in the housing (2), and a piston (7, 7a) with a shank (6) displaceable in the cylinder (8) for driving a nail or a fastening element (4) in a workpiece. For retention of the piston (7, 7a) during the

displacement of the cylinder (8), there are provided permanent magnets (7b) (column 4, lines 16-18).

The stop (10a) which, in the Office Action, is compared with the stop of the present invention that is fixedly secured in the housing and projects in the guide cylinder, is arranged on the combustion chamber housing (10) in order to limit the displacement of the guide cylinder (8) and the combustion chamber wall (11) in the drive-in direction (column 4, lines 25-28). The stop (10a) does not limit the movement of the piston (7) in the cylinder (8), as recited in claim 15 of instant application.

Further, Gschwind does not disclose any engagement member that engages the piston (7) in a direction opposite the direction of the advance of the piston, as again recited in claim 15 of instant application. While the Office Action mentions “an engagement pad for engagement the piston (7, 7a) driven opposite the direction of advance of the piston (8) (sic) by the elastic adjusting element after extension of the guide cylinder (8) out of the device housing” (page 3, lines 4-7), there is no indication what element serves as “an engagement pad.” Having carefully reviewed Gschwend, applicants were unable to ascertain which element could be considered as an “engagement pad.”

Further, the Office Action mentions “an elastic adjustment element (32) (page 3, line 3). The spring (32) is arranged between the housing and a latch (31) which is fixedly secured to a tubular element (30) (Fig. 2). The spring (32) serves for biasing the element (30) rearwardly for displacing the handle on the rear housing part away from the first housing part (column 6, lines 48-55). The spring (32) is tensioned when the handle (3) is displaced relative to the housing (2). However, during this movement of the spring (32), the guide cylinder (8) is displaced to expand the combustion chamber (Fig. 1) but not to extend into the housing. The guide cylinder (8) is displaced into the housing by a gear train (G) when the spring (32) displaced the handle (3) away from the housing (2). The spring (32) does not affect the movement of the piston (7) in any way.

It follows from the foregoing discussion that Gschwend discloses a structure that is formed differently and operates differently. Gschwend does not disclose or even suggests (i) a stop integral with the housing and projecting into the guide cylinder to delimit the engagement of the piston in the direction of advance of the piston; (ii) an elastic adjusting element as claimed; and (iii) an engagement part for engaging the piston in the direction opposite the direction of advance of the piston.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Gschwend does not disclose a working tool as claimed. Since Gschwend fails to disclose each and every feature of independent Claim 15, Gschwend, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Gschwend does not anticipate or make obvious the present invention as defined in Claim 15, and the present invention is patentable over Gschwend.

Claims 2-14 depend on claim 15 and are allowable for the same reasons claim 15 is allowable and further because of specific features recited therein which, when taken alone and/or combination with features of claim 15, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction to be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

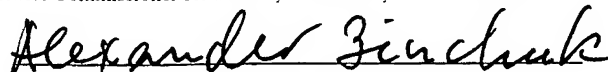


Alexander Zinchuk

Reg. No. 30,541

Date: April 6, 2006
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9383

This correspondence is being deposited with the United States Postal Service on April 6, 2006 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER 059 675 728 US addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.


Alexander Zinchuk